The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YANG XU and TERESA LECHNER-FISH

Appeal No. 2003-1920
Application No. 09/538,455

ON BRIEF

Before KIMLIN, PAK, and JEFFREY T. SMITH, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

This case is not ripe for meaningful review and is, therefore, remanded to the examiner for appropriate action consistent with the views expressed below.

At pages 8 and 9 of our decision entered September 30, 2003, Paper No. 21, we set forth the following conclusions:

> 1) The examiner's Section 102(e) rejection of claims 1 through 8, 20 through 24 and 26 through 30 [as anticipated by the disclosure of Higdon] is reversed;

2) The examiner's Section 102(e) rejection of claims 9 through 12 [as anticipated by the disclosure of Higdon] is affirmed;

3) The examiner's Section 103 rejection of claims 13 through 17 [as unpatentable over the combined disclosures of Higdon and Upchurch] is affirmed; and

4) The application is returned to the examiner to properly interpret the means-plus-function limitations recited in claim 25 and determine the applicability of the examiner's Section of 102 rejection of claim 25 in view of this proper interpretation.

With respect to the last conclusion set forth above, we provided our reasons for returning the application to the examiner at page 6 of our decision entered September 30, 2003 as shown below:

> The examiner fails to properly interpret the means-plus-function limitations recited in claim 25 consistent with ***In re Donal[d]son [Co.]***, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)(***[e]n banc***). In other words, the examiner has not properly interpreted the claimed means-plus-function limitations as the corresponding structures described in the specification and the equivalents thereof. As a result of this misinterpretation, the examiner has not properly considered the disclosure of Higdon. Accordingly, we remand this application to the examiner to consult the specification to define the structures corresponding to the claimed means-plus-function limitations and the equivalents thereof and to determine the applicability of the teachings of Higdon based on this proper construction.[1]

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[1] Implicit in our decision was that the examiner's Section 102(e) rejection of claim 25 was vacated.

At no time, did we authorize the examiner to submit a Supplemental Answer to address the above matter consistent with 37 CFR § 1.193(b)(1)(2003). See the decision entered September 30, 2003 in its entirety. As a result, the examiner must reopen the prosecution of this application if any rejection was warranted. Procedural due process demanded that the appellants be given an ample opportunity to respond to the examiner's new reasoning in support of any appropriate rejection.

Rather than reopening the prosecution of this application, however, the examiner submitted a Supplemental Answer supposedly responding to our remand order above. See the second Answer dated July 2, 2004, pages 5-7, Paper No. 22. This submission of the Supplemental Answer was improper since we did not authorize the examiner to submit a Supplemental Answer consistent with 37 CFR § 1.193(b)(1)(2003). If any rejection was warranted, the examiner "should [have] submit[ted] the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR [§] 1.198 . . . . " *See Manual of Patent Examining Procedure (MPEP)* § 1214.04 (Rev. 1, August 2001).

In the Supplemental Answer, the examiner also appeared to question the reversal of the examiner's Section 102(e) rejection of claims 1 through 8, 20 through 24 and 26 through 30 set forth

in our decision entered September 30, 2003. See the second Answer dated July 2, 2004, pages 3-5, Paper No. 22. It appears that the examiner was asking for a rehearing of our decision entered September 30, 2003. According to *MPEP* § 1214.04 (Rev. 1, August 2001):

> All requests by the examiner to the Board for rehearing of a decision must be approved by the TC Director and must also be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for approval before mailing.

The examiner, however, again did not follow the procedure set forth in the *MPEP*. In view of the foregoing, we remand this application to the examiner again to follow the proper procedures indicated above if any rejection of the claimed subject matter and/or any rehearing of our decision entered September 30, 2003 is warranted. We do not authorize the examiner to submit any Supplemental Answer in responding to this Remand Order.

This application, by virtue of its "special" status requires immediate action. *See Manual of Patent Examining Procedure* (*MPEP*) 708.01 (8th Ed., Rev. 1, Feb. 2003). It is important that the Board be informed promptly of any action affecting the appeal in this application.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REMANDED

EDWARD C. KIMLIN)
Administrative Patent Judge)
)
)
CHUNG K. PAK) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
JEFFREY T. SMITH)
Administrative Patent Judge)

CKP:hh

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